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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/528,018

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Markus Warsta

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EXAMINER

DANIEL JR, WILLIE J

ART UNIT

PAPER NUMBER

2617

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/528,018

**Applicant(s)**

WARSTA ET AL.

**Examiner**

WILLIE J. DANIEL JR

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 March 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to application filed 12 May 2005 (including amendment filed on 16 March 2005). **Claims 1-21** are now pending in the present application. This office action is made **Non-Final**.

#### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on
  - a. 16 March 2005is in compliance with the provisions of 37 CFR 1.97 and is being considered by the examiner.

#### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "18" has been used to designate both "CCD" and "PGW" of Fig. 5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description:

a. Fig. 5 "ref. 18".

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

a. "ref. 16" see pg. 12, 1<sup>st</sup> full par.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. This list of examples is not intended to be exhaustive.

### ***Specification***

7. The disclosure is objected to because of the following informalities:

- a. The specification recites the language "...calls to **her**..." on pg. 8, 1<sup>st</sup> par., line(s) 7.

The Examiner interprets as --calls to the **subscriber**-- and suggests replacing said language to help clarify the specification.

- b. The specification recites the language "...purposes.**Additional**..." on pg. 12, 3<sup>rd</sup> full par., line(s) 2. The Examiner interprets as --purposes. **Additional**-- and suggests replacing said language to help clarify the specification.

Appropriate correction is required.

8. This list of examples is not intended to be exhaustive.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5 and 10-16** are rejected under 35 U.S.C. 102(e) as being anticipated by **Boivin** (US 2003/0092436 A1).

Regarding **claims 1 and 19-21**, Boivin discloses a method of managing subscriber data in a communications network (see Fig. 2), the method comprising:

sending a message associated with a subscriber and including data relating to the identity of said subscriber (see pg. 3, [0026]), where the system is informed of a previously used telephone number;

selectively routing said message based on the identity of said subscriber and on routing information stored at a register, to one of a first network entity and a second network entity (see pg. 2, [0019-0020]; pg. 3, [0025-0026]; Fig. 2), where the call is communicated via the MSC (208) to the PSP (202),

wherein said message is routed to the first network entity when it is determined that the subscriber is inactive and to the second network entity when it is determined that the subscriber is active subsequent to receiving said message at the first network entity (see pg. 3, [0028, 0030]), where the system determines that the number is inactive and activates the telephone number,

provisioning a second network entity with subscriber data required by said second network entity to be able to service said subscriber (see pg. 3, [0030]; pg. 2, [0019-0020]; Fig. 3 'ref. 312'), where the system activates the telephone number; and

updating routing information associated with the subscriber at the register to route subsequent signalling to the second network entity (see pg. 3, [0030]; pg. 2, [0019-0020]), where the system updates the routing information for incoming and outgoing communication.

Regarding **claim 2**, Boivin discloses a method as claimed in claim 1 further comprising:

storing a plurality of subscriber identities at the first network entity (see pg. 2, [0017-0018, 0020]); and

provisioning the second network entity with subscriber data if the data relating to the identity of the subscriber in the message corresponds to one of said plurality of subscriber identities (see pg. 3, [0030]; pg. 2, [0019-0020]), where the system updates the routing information for incoming and outgoing communication.

Regarding **claim 3**, Boivin discloses a method as claimed in claim 1 wherein the message is sent from a mobile station of the subscriber (see pg. 3, [0026]), where the system is informed of a previously used telephone number (see pg. 2, [0021, 0023]; Fig. 3).

Regarding **claim 4**, Boivin discloses a method as claimed in claim 3 wherein the message includes International Mobile Subscriber Identity (IMSI) (see pg. 2, [0017-0018]).

Regarding **claim 5**, Boivin discloses a method as claimed in claim 3 wherein the message further includes data relating to the location of the mobile station (see pg. 2, [0019-0020]).

Regarding **claim 10**, Boivin discloses a method as claimed in claim 1 wherein the message is sent to the register via a second register (see pg. 3, [0030]; pg. 2, [0019-0020]), where the system updates the routing information for incoming and outgoing communication.

Regarding **claim 11**, Boivin discloses a method as claimed in claim 1 wherein the register comprises a service routing register (e.g., service control point 118) (see pg. 3, [0030]; pg. 2, [0019-0020]; Figs. 1-2).

Regarding **claim 12**, Boivin discloses a method as claimed in claim 1 wherein the first network entity comprises a provisioning home location register (PHLR) (e.g., server 218) (see pg. 3, [0030]; pg. 2, [0019-0020]; Figs. 1-2).

Regarding **claim 13**, Boivin discloses a method as claimed in claim 1 wherein the second network entity comprises a home location register (HLR) (see pg. 2, [0017-0019]; Figs. 1-2).

Regarding **claim 14**, Boivin discloses a method as claimed in claim 10 wherein said second register comprises a visitor location register (VLR) (see pg. 2, [0017-0019]; Figs. 1-2).

Regarding **claim 15**, Boivin discloses a method as claimed in claim 1, wherein the second network entity comprises one of: a voicemail system entity; a mail server entity; a multimedia messaging server entity; a wireless application part gateway entity; a prepaid server entity (e.g., prepaid server platform (PSP) 202; intelligent network server; short message service centre; location based service centre; USSD-centre; GPRS-server; charging and rating server (see Fig. 2)).



Regarding **claim 16**, Boivin discloses a method as claimed in claim 1, comprising provisioning at least one further network element with subscriber data (see pg. 3, [0030]; pg. 2, [0019-0020]; Fig. 3).

**Claims 17-18** are rejected under 35 U.S.C. 102(c) as being anticipated by **Coad et al.** (hereinafter Coad) (**US 2003/0190913 A1**).

Regarding **claim 17**, Coad discloses a method for managing subscriber data in a communications network (see pg. 1, [0028]; pg. 2, [0041-0042]), the method comprising:

- determining that a subscriber has become inactive in at least one network entity arranged to provide subscriber data for use in servicing the subscriber (see pg. 1, [0026, 0009]);
- creating a profile relating to the subscriber at an auxiliary network entity (see pg. 1, [0028]);
- updating the information stored at a routing register to route subsequent signalling associated with the subscriber to the auxiliary (PHLR) network entity (see pg. 1, [0027-0028]); and
- deleting a profile relating to the subscriber data from the at least one network entity (see pg. 2, [0036-0037]).

Regarding **claim 18**, Coad discloses a method as claimed in claim 17 further comprising determining that a subscriber has become inactive if the time lapsed since a last message, associated with the subscriber, was routed exceeds a predetermined time (see pg. 2, [0035-0037]).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 6-9** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Boivin (US 2003/0092436 A1)** in view of **Kowarsch (US 2004/0132449 A1)**.

Regarding **claim 6**, Boivin discloses every limitation claimed as applied above in claim 3. Boivin does not specifically disclose having the feature(s) sending data from the first network entity to the mobile station to provide the subscriber with a preliminary service. However, the examiner maintains that the feature(s) sending data from the first network entity to the mobile station to provide the subscriber with a preliminary service was well known in the art, as taught by Kowarsch.

In the same field of endeavor, Kowarsch discloses the feature(s) sending data from the first network entity to the mobile station to provide the subscriber with a preliminary service (see pg. 7, [0134]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boivin and Kowarsch to have the feature(s) sending data from the first network entity to the mobile station to provide the subscriber with a preliminary service, in order to permit a mobile station from a home network to operate in a visited network, as taught by Kowarsch (see pg. 3, [0019]).

Regarding **claim 7**, Boivin discloses every limitation claimed as applied above in claim 6. Boivin inexplicitly discloses having the feature(s) wherein said data sent from the first network entity to the mobile station further comprises authentication information. However, the examiner maintains that the feature(s) wherein said data sent from the first network entity to the mobile station further comprises authentication information was well known in the art, as taught by Kowarsch.

In the same field of endeavor, Kowarsch discloses the feature(s) wherein said data sent from the first network entity to the mobile station further comprises authentication information (see pg. 8, [0139, 0152]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boivin and Kowarsch to have the feature(s) wherein said data sent from the first network entity to the mobile station further comprises authentication information, in order to permit a mobile station from a home network to operate in a visited network, as taught by Kowarsch (see pg. 3, [0019]).

Regarding **claim 8**, Boivin discloses every limitation claimed as applied above in claim 6. Boivin inexplicitly discloses having the feature(s) wherein said preliminary service comprises transmitting a notification message to the mobile station to notify the subscriber that a service request has been acknowledged. However, the examiner maintains that the feature(s) wherein said preliminary service comprises transmitting a notification message to the mobile station to notify the subscriber that a service request has been acknowledged was well known in the art, as taught by Kowarsch.

In the same field of endeavor, Kowarsch discloses the feature(s) wherein said preliminary service comprises transmitting a notification message to the mobile station to notify the subscriber that a service request has been acknowledged (see pg. 8, [0139, 0152]), where system provides communication for the MS (11) in which a notification message would be inherent since the user is able to utilize the system for communication.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Boivin and Kowarsch to have the feature(s) wherein said preliminary service comprises transmitting a notification message to the mobile station to notify the subscriber that a service request has been acknowledged, in order to permit a mobile station from a home network to operate in a visited network, as taught by Kowarsch (see pg. 3, [0019]).

Regarding **claim 9**, the combination of Boivin and Kowarsch discloses every limitation claimed, as applied above (see claim 6), in addition Boivin further discloses wherein said notification message comprises a voice announcement (see Fig. 2 'ref. 222'). As a note, Kowarsch at the least further the feature wherein said notification message comprises a voice announcement (see pg. 13, [0210]).

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIE J. DANIEL JR whose telephone number is (571)272-7907. The examiner can normally be reached on 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. J. D., Jr./

WJD, Jr.

/Charles N. Appiah/  
Supervisory Patent Examiner, Art Unit 2617